

REMARKS

The Office Action

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,314,398 to Junqua, et al. ("Junqua") in view of U.S. Patent No. 6,996,531 to Korall, et al. ("Korall").

Comments/Arguments

The rejection of the claims is hereby traversed. Significantly, the claims distinguish patentably over the prior art. That is to say, the references fail to teach each and every claimed feature. Moreover, the rejection is erroneous because there is improper and/or inadequate motivation to combine the references as proposed by the Examiner.

It is widely accepted that the initial burden of establishing a *prima facie* conclusion of obviousness rests with the Examiner. See, e.g., the Manual of Patent Examining Procedure (MPEP) §2142. In the present instance, the Examiner fails to establish a *prima facie* case of obviousness. Accordingly, the rejection of the claims is hereby traversed.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2142. Significantly, the combination of references in this case fail to teach or suggest all the claim limitations. Moreover, the Examiner provides no suitable motivation for making the proposed combination.

When making a rejection under 35 U.S.C. §103, the Examiner is required to set forth in the Office Action: (i) the proposed modification of the reference necessary to arrive at the claimed subject matter, and (ii) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. See MPEP §706.02(j) (C) and (D). The Examiner in the present case sets forth neither of these requirements in the Office Action. Rather, the Examiner

merely indicates that it would have been obvious to incorporate the teachings of Korall into the system of Junqua. This merely conclusory statement is without any supporting evidence or rational, and is inadequate to maintain a *prima facie* case of obviousness.

With regard to item (i) above, nowhere does the Office Action indicate with any specificity how Junqua is being modified by Korall. The Office Action merely states that it would have been obvious “to utilize the teaching of Korall to the system of Junqua.” This statement in no way describes how Junqua is being modified by Korall.

With regard to item (ii), there is no appropriate motivation for making the combination. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP §2143.01(III). Notably, the entire system 10 of Junqua is incorporated into a set-top decoder box 52 or the television 50 itself. See, FIGURE 1 and column 3, lines 10-17. Accordingly, the proposed motivation cited in the Office Action (i.e., “to formulate searchable text query from telephone input for accessing database”) simply does not make any sense. One of ordinary skill in the art would not be motivated to access the database 18 via a telephone call insomuch as the database 18 is already present on the TV 50 or set-top box 52 at the user’s location.

Additionally, the Examiner provides no suitable support for the obviousness rejection. That is, the motivation for any proposed combination is not expressly recited in the prior art. The Examiner’s statements in this regard simply lack any supporting evidence in the record.

Again, the MPEP is instructive on this point. “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP §2143.01. Insomuch as neither Junqua nor Korall expressly provides the motivation for making the proposed combination, presumably the Examiner is relying on what is well-known prior art or common knowledge in the art.

Surely, the Examiner is well aware that the Applicant is required to reasonably challenge statements by the Examiner that are not supported by evidence on the record, and that failure to do so will be construed as an admission by the Applicant that the statements are true. See, e.g., MPEP §2144.03. Therefore, in accordance with the

Applicant's duty to seasonably challenge such unsupported statements, the Examiner is respectfully requested to cite one or more specific references that provide the motivation for the proposed combination. Compliance with MPEP §2144.03 mandates that if an Examiner is to properly maintain a rejection then documentary evidence must be supplied when the Applicant traverses the Examiner's assertions with respect to what is well-known or common knowledge in the art. Alternately, if the Examiner is unable to provide the required evidence by way of a cited reference, and is instead relying on their own personal knowledge, Applicant hereby requests that the evidence be provided in the form of an affidavit from the Examiner under 37 C.F.R. §104(d)(2). Absent substantiation on the record by the Examiner, it is respectfully requested that the rejection under 35 U.S.C. §103(a) be withdrawn.

Finally, according to MPEP §2141(a), for a reference to be relied upon under 35 U.S.C. §103, it must be analogous art. In the present case, Korall is non-analogous art. Importantly, Junqua is directed to an interactive television channel selection apparatus and method. Korall, on the other hand, is directed to an automated directory assistance system, e.g., for obtaining telephone numbers and/or other directory assistance information.

Notwithstanding the inappropriateness of the combination, Junqua in view of Korall still fails to teach all the claimed features. Accordingly, the claims distinguish patentably over the prior art.

More specifically, e.g., claim 11 is directed to a service control point connected to a telephone system and a television system. Neither Junqua nor Korall disclose such a service control point.

Additionally, claim 2 calls for "identifying the viewer from which the telephone call is received via caller ID." Claim 18 recites identification means for identifying the viewer from which a call is received, and claim 19 calls for the identification means to comprise caller ID. The Office Action concedes that Junqua fails to disclose the foregoing. However, the Office Action erroneous alleges that Korall does disclose the foregoing. In support of this position, the Office Action references col. 9, line 65 through col. 10, line 3. However, the cited passage is not referring to caller ID or even identifying the user. Rather, Korall is referring to a reverse directory look-up where a user enters a telephone number and the output is the name of the subscriber associated with that telephone

number. This is not the same as caller ID and it does not identify the individual calling directory assistance to perform the search.

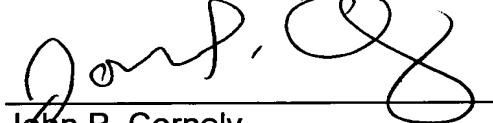
CONCLUSION

For the reasons detailed above, it is respectfully submitted that all the claims remaining in the application are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to telephone the below signed, at the telephone number listed.

Respectfully submitted,

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